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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/02/1999

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10/05/2006

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EXAMINER

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/324,601
Filing Date: June 02, 1999
Appellant(s): ROBERTSON, STEVEN C.

MAILED

OCT 05 2006

GROUP 3600

Patrick Michael Dwyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/28/2006 appealing from the Office action mailed 5/9/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The grounds of rejection argued

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by appellant, Item I, pages 6-12, concerning Rule 131 Declaration and the USC 103 rejection were withdrawn when a new grounds of rejection was introduced in the 5/9/2006 office Action.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,010,512

Gillin et al

3-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillin.

In regards to claim 23, Gillin discloses a system for providing an electronic gift certificate service for users over a distributed network (abstract), comprising:

- a plurality of merchant sites connected to the distributed network (abstract, any merchant),

- each merchant site running at least one application to provide an online service to users over the distributed network (col 10, lines 36-50);

- a plurality of user computers connected to the distributed network (FIG 3),

- each user computer running at least one application to access the online service at a merchant site (FIG 3);

- a gift certificate authority site connected to the plurality of merchant sites (FIG 1),

- the gift certificate site including a user database and a merchant database (col 15 line 15 – col 17, line 9),

- each database containing authentication information as to respective users and merchants, and a gift certificate database which stores gift certificate data and transaction data related to particular gift certificates (col 18, lines 15-43),

- the users accessing the merchant sites from the user computers over the distributed network (FIG 1); and

- an authentication protocol for allowing the gift certificate site to authenticate users and merchants (col; 18, lines 15-45);

- whereby a user purchases a gift certificate having a unique gift certificate identification code on the gift certificate authority site for use at a merchant site (, and

- a merchant site processes the gift certificate through the gift certificate database on the gift certificate authority site (col 23, line 44 – col 24, line 40).

In regards to claim 24, Gillin teaches during user purchase of a gift certificate, the user placing restrictions on the use of the gift certificate ((col 23, line 44 – col 24, line 40).

In regards to claim 25, Gillin teaches tracking use of the gift certificate by the user col 23, line 45-50).

In regards to claim 26, Gillin teaches a search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate (col 20, lines 25-60)

In regards to claim 27, Gillin teaches user anonymity that is effected by preventing merchant site access to any user related data, other than the gift certificate identification code (col 20, lines 25-60).

In regards to claim 28, Gillin teaches within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites (col 5, lines 10-20).

In regards to claim 29, Gillin discloses method for a user to purchase a gift certificate from an on-line gift certificate service, the method comprising the steps of:
user enters a desired dollar amount to be applied to the gift certificate (col 23, lines 44-46);

user enters a user-selected personal identification number (PIN) for authentication in a gift certificate redemption process (col 18, lines 16-43);

user provides payment information to the gift certificate site for purchasing the gift certificate (col 24, lines 25-40);

gift certificate site validates user payment information (col 24, lines 25-40); and
user receives an gift certificate order confirmation, including a unique gift certificate identification code (col 24, lines 1-40).

In regards to claim 30, Gillin teaches ahead of the step of gift certificate site validation, the user associates a fixed shipping address with the gift certificate (col 17, lines 30-55).

In regards to claim 31, Gillin teaches ahead of the step of gift certificate site validation,

the user associates a restriction on certificate use the restriction selected from the group of restrictions consisting of restriction on certificate use by category of product or service, restriction on certificate use by age range of product or service, restriction on certificate use by dollar limitations on a per order or per item basis, restriction on certificate use by date of use range, and restriction on certificate use to use at selected merchant sites (col 23, lines, 45-55).

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In regards to claim 32, Gillin teaches the method of claim 31 wherein the restriction on certificate use is a restriction on certificate use by category of product or service (see response to claim 31).

In regards to claim 33, Gillin teaches in the step of gift certificate order confirmation, the user selectively elects either immediate online display of the order confirmation, or later e-mail notification, or both (col 24, lines 1-40).

In regards to claim 34, Gillin discloses a method for redeeming a gift certificate from an on-line gift certificate service at a merchant site, the method comprising the steps of

- user elects gift certificate as form of payment for selected goods or services at merchant site;

- user enters unique gift certificate identification code and user selected PIN; and
- merchant site communicates over distributed network with gift certificate authority site to authenticate the user gift certificate and complete user purchase of selected goods or services (FIG 6B-1).

In regards to claim 35, Gillin discloses a system for providing an electronic contribution service for users over a distributed network, comprising:

- a plurality of beneficiary sites connected to the distributed network (,
- each beneficiary site running at least one application to provide an online service to users over the distributed network;

- a plurality of user computers connected to the distributed network,
- each user computer running at least one application to access the online service at a beneficiary site;

- a contribution authority site connected to the plurality of beneficiary sites,
- the contribution site including a user database and a beneficiary database,
- each database containing authentication information as to respective users and beneficiaries, and

- a contribution database which stores contribution data and transaction data related to particular contributions,

- the users accessing the beneficiary sites from the user computers over the distributed network; and

- an authentication protocol for allowing the contribution site to authenticate users and beneficiaries;

whereby a user makes a contribution having a unique contribution identification code on the contribution authority site for use at a beneficiary site, and a beneficiary site processes the contribution through the contribution database on the contribution authority site (see response to claim 1).

Gillen teaches a recipient and a gift certificate site (see claim 1). Since changing the recipient to "beneficiary" and gift certificate site to "contributory authority" does not impart any functionality these limitations are considered to be non-functional descriptive material (see MPEP 2106(b) and are therefore not considered to provide patentable

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distinction. The examiner contends that the system would work equally well with any recipient and any designated gift certificate site.

In regards to claim 36, Gillin teaches the contribution database, and in conjunction with beneficiary site processing of the contribution through the contribution database, the contribution is set up to be selectively one-time or recurring automatic (col 26, lines 50-53).

In regards to claim 37, Gillin teaches user anonymity that is effected by preventing beneficiary site access to any user related data, other than the contribution identification code (col 20, lines 25-60).

(10) Response to Argument

Appellant argues that the examiner has not pointed out where the elements are in the reference. To better help the appellant understand the teachings of Gillin the examiner has mapped the appellant's claims.

Appellant argues that there is no relationship between the issuer and the merchant and therefore Gillen teaches away from the instant invention. The examiner disagrees and points out that clearly there is a relationship since merchants must be registered to be able to accept the form of payment that is the gift certificate.

Appellant argues that Gillin does not teach a database containing merchant and user authentication. The examiner disagrees and directs the appellant's attention to FIG 6B-1 where the system collects authorization and passwords from merchants and users.

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., gift certificate agent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that Gillin does not teach all the restrictions of the instant invention particularly “the transfer instrument of Gillin could never restrict where purchases might be made”. The examiner points out that claim 29 and 30 introduce the restriction as to where purchases might be made and since the claims select from a group of restrictions, only one of the restrictions needs to be present in Gillin to meet the scope of the claim.

Appellant argues that Gillin does not teach a fixed shipping address. The examiner disagrees and directs the appellant’s attention to col 2, lines 30-36, where a shipping address is pre-established and restricted.

Appellant argues that Gillin does not teach contribution management. As stated above the renaming of the entities in the system as presented in claim 1 is considered to be non-functional language.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., direct deposit to a beneficiaries bank account, so that all contributions effected through the claimed system are aggregate and fungible for any particular charity.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant argues that the examiner has made no attempt to address arguments presented in the original brief. The examiner agrees and notes that a new grounds of rejection was provided and the examiner has in this answer addressed any and all arguments directed towards the office action mailed 5/9/2006.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Fadok
Primary Examiner
September 11, 2006

Conferees



Jeffrey Smith
Supervisor Patent Examiner
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Matt Gart
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